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10/648,048

08/26/2003

Timothy Baker

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EXAMINER

CHOI, STEPHEN

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/648,048
Filing Date: August 26, 2003
Appellant(s): BAKER, TIMOTHY

Roger D. Greer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 10, 2008 appealing from the Office action mailed February 06, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,607,092	Rubly	8-1952
2,900,856	Maier	8-1959

4,334,522	Dukess	6-1982
5,982,059	Anderson	11-1999
6,048,260	Kopras	4-2000
6,481,130	Wu	11-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maier (US 2,900,856) in view of Anderson (US 5,982,059).

Maier discloses the invention substantially as claimed except for a magnet, an electrical circuit including at least one light producing device, and a lens. Anderson teaches a magnet (32) mounted on a rotatable shaft, an electric circuit (52) including at least one light producing device (54), and a lens (col. 5, line 35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a lighting assembly as taught by Anderson on the device of Maier in order to provide light onto a work without a separate external source of energy. Regarding claim 2, col. 5, lines 14-16 of Anderson. Regarding claim 3, col. 4, line 11-col. 5, line 12 of Anderson. Regarding claim 8, the element 26 of Anderson is C-shaped. Regarding claim 9, a distal end of 13 of Maier is capable of receiving a saw guard. Regarding claim 10, at 40 of Maier.

Claims 1-4 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopras (US 6,048,260) in view of Anderson.

Kopras discloses the invention substantially as claimed except for a magnet, an electrical circuit including at least one light producing device, and a lens. Anderson teaches a magnet (32) mounted on a rotatable shaft, an electric circuit (52) including at least one light producing device (54), and a lens (col. 5, line 35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a lighting assembly as taught by Anderson on the device of Kopras in order to provide light onto a work without a separate external source of energy. Regarding claim 2, col. 5, lines 14-16 of Anderson. Regarding claims 3 and 12, col. 4, line 11-col. 5, line 12 of Anderson. Regarding claim 8, the element 26 of Anderson is C-shaped.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maier in view of Anderson as applied to claim 1 above, and further in view of Wu (US 6,481,130) and Dukess (US 4,334,522).

The modified device of Maier discloses the invention substantially as claimed except for the lens being made of a transparent plastic material and has an elongated narrow configuration. Wu teaches a transparent lens having an elongated narrow configuration. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a lens taught by Wu on the modified device of Maier in order to evenly illuminate a work. Although Wu does not expressly teach the lens being made of plastic material, a lens made of plastic material is old and well known as evidenced by Dukess.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maier in view of Anderson as applied to claim 1 above, and further in view Rubly (US 2,607,092).

The modified device of Maier discloses the invention substantially as claimed except for a compression band and a lever mechanism. Rubly discloses a compression band with a lever mechanism. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a clamping mechanism as taught by Rubly on the modified device of Maier in order to secure the attachment.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maier in view of Kopras as applied to claim 1 above, and further in view of Wu and Dukess.

The modified device of Kopras discloses the invention substantially as claimed except for the lens being made of a transparent plastic material and has an elongated narrow configuration. Wu teaches a transparent lens having an elongated narrow configuration. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a lens taught by Wu on the modified device of Kopras in order to evenly illuminate a work. Although Wu does not expressly teach the lens being made of plastic material, a lens made of plastic material is old and well known as evidenced by Dukess.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maier in view of Kopras as applied to claim 1 above, and further in view Rubly.

The modified device of Kopras discloses the invention substantially as claimed except for a compression band and a lever mechanism. Rubly discloses a compression band with a lever mechanism. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a clamping mechanism as taught by Rubly on the modified device of Kopras in order to secure the attachment.

(10) Response to Argument

Appellant contends that combinations of Maier modified by Anderson or Kopras modified by Anderson are based upon improper hindsight reconstruction. Appellant further contends that there is no motivation for the combinations.

The court has held that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The court has also held that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Anderson clearly teaches that providing a generator and lighting assembly for use with a power driven tool is well known knowledge within the level of

ordinary skill at the time the claimed invention was made. Furthermore, applicant's background of the invention clearly admits that such knowledge was well known within the level of ordinary skill at the time the claimed invention was made. Thus, the examiner's reconstruction is not based knowledge gleaned only from the applicant's disclosure but rather knowledge that was well known within the level of ordinary skill at the time the claimed invention was made. Furthermore, Anderson recognizes advantages of providing a lighting assembly powered by mechanical movement of the tool without a separate external source of energy and provides motivation to employ such a lighting assembly on a power tool such as a tool taught by Maier or Kopras.

Furthermore, appellant argues that Maier teaches a tool rather than an attachment for a tool as claimed.

The examiner respectfully disagrees. Maier teaches a structure that is attached to a motor driven assembly (e.g., 37). Thus, it is clearly an attachment as claimed.

Appellant also appears to believe the examiner's rejection is stating that "a face plate" in Anderson is referred to as "lens".

The examiner respectfully directs appellant's attention to Col. 5, lines 34-35 where Anderson teaches "a retainer 62 for securing the face plate and lens in place". Anderson clearly states that "a face plate" is not "lens" rather they are separate elements of the device.

Moreover, appellant argues that there is no motivation for combining six references and the rejections is based upon improper hindsight reasoning.

The examiner respectfully submits that the court has held that reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Furthermore, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, appellant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the appellant has submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Art Unit: 3726

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stephen Choi/

Primary Examiner, Art Unit 3724

Conferees:

/Boyer D. Ashley/
Boyer Ashley
Supervisory Examiner

/David P. Bryant/
David Bryant
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